

**REMARKS**

The Office Action mailed December 13, 2004 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

Claims 19, 25 and 31 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes may be found in the specification, page 13, lines 5-24. The text of claims 20-24, 26-30, and 32-33 is unchanged, but their meaning is changed because they depend from amended claims.

Claim 26 has been canceled, without prejudice or disclaimer of the subject matter contained therein.

**Informal Objections**

With this amendment it is respectfully submitted the claims satisfy the statutory requirements.

**The 35 U.S.C. § 102 Rejection**

Claims 19-23 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by McIntosh.<sup>1</sup> This rejection is respectfully traversed.

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>2</sup>

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<sup>1</sup> U.S. Patent No. 5,103,404.

<sup>2</sup> Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 19

With respect to claim 19, the examiner cites McIntosh as showing motors/actuators configured to provide modulated force feedback (column 4, lines 37-41). In column 2, lines 58-64 of McIntosh, the force value is based on the timed difference between the load motor encoder and the control motor encoder. In the invention described in claim 19, however, the force value is based on the position of the actuator and the torque profiles residing in EEPROM. Claim 19 is therefore amended to particularly point out and distinctly claim subject matter regarded as the invention.

Claim 20-24

As to dependent claims 20-24, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

Claim 25

With respect to claim 25, the examiner cites McIntosh as showing motors/actuators configured to provide modulated force feedback (column 4, lines 37-41). In column 2, lines 58-64 of McIntosh, the force value is based on the timed difference between the load motor encoder and the control motor encoder. In the invention described in claim 25, however, the force value is based on the position of the actuator and the torque profiles residing in EEPROM. Claim 19 is therefore amended to particularly point out and distinctly claim subject matter regarded as the invention.

Claim 26

With respect to claims 26, claim 26 is cancelled herewith, accordingly with respect to this claim, the rejection is now moot.

Claim 27-30

As to dependent claims 26-30, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

Claim 31

With respect to claim 31, the examiner cites McIntosh as showing motors/actuators configured to provide modulated force feedback (column 4, lines 37-41). In column 2, lines 58-64 of McIntosh, the force value is based on the timed difference between the load motor encoder and the control motor encoder. In the invention described in claim 31, however, the force value is based on the position of the actuator and the torque profiles residing in EEPROM. Claim 19 is therefore amended to particularly point out and distinctly claim subject matter regarded as the invention.

Claim 32-33

As to dependent claims 32-33, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The 35 U.S.C. § 103 Rejection

Claims 24, 26 and 28 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over McIntosh, none of which are independent claims. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.<sup>3</sup>

Claims 24 and 28

With respect to claims 24 and 28, the Office Action contends that the elements of the presently claimed invention are disclosed in McIntosh except that McIntosh does not teach RAM and ROM components internal to the microprocessor.<sup>4</sup> The Office Action further contends that McIntosh teaches RAM and ROM components external to the microprocessor and that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate RAM and ROM into the microprocessor in order to reduce the number of parts needed to fabricate the invention. The Applicants respectfully disagree for the reasons set forth below.

The ROM specified in figure 10 of McIntosh must necessarily be separate from the microprocessor; the ROM is used to provide "preprogrammed control data" for the

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<sup>3</sup> M.P.E.P § 2143.

<sup>4</sup> Office Action ¶ 4.

microprocessor (column 10, lines 3-5). If the preprogrammed ROM were incorporated into the microprocessor, then each set of control data would necessarily require a separate microprocessor\ROM combination. Further, McIntosh clearly delineates that the ROM is a separate "functional block" from the microprocessor and from the RAM memory (column 10, line 63 – column 11, line 1).

The Office action admits that McIntosh does not teach RAM and ROM components internal to the microprocessor, but does not provide a specific reference where such a limitation is found, instead arguing that one of ordinary skill in the art would have found it obvious to modify the invention in Challenger to arrive at the additional claim limitation. Therefore, applicant assumes that the Office Action intended to take official notice of facts under M.P.E.P. 2144.03 that the rationale supporting the obviousness rejection is based on common knowledge in the art or "well-known" prior art. Under M.P.E.P. 2144.03, "[i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." Applicant hereby traverses the assertion and requests that a reference be cited in support of the position outlined in the Office Action.

#### Claim 26

With respect to claims 26, claim 26 is cancelled herewith, accordingly with respect to this claim, the rejection is now moot.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Request for Entry of Amendment

Entry of this Amendment will place the Application in better condition for allowance, or at the least, narrow any issues for an appeal. Accordingly, entry of this Amendment is appropriate and is respectfully requested.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

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